

REMARKS

Claims 1-14 are pending, of which claims 10-14 have been withdrawn as being directed to a non-elected invention. Accordingly, claims 1-9 have been examined in the current Office Action. Claims 1-3 have been rejected under 35 U.S.C. § 112, second paragraph, under 35 U.S.C. § 101 and under 35 U.S.C. § 103(a).

I. Preliminary Matters

The Examiner has objected to claims 4-9 as being in improper form due to multiple dependency issues. Accordingly, Applicant has amended the claims in a manner believed to overcome the rejection. In view of the amendments, Applicant respectfully requests the Examiner to examine claims 4-9 on their merits in the next Office Action.

II. Rejections under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 1-3 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Examiner maintains that the claims are not properly claimed as either a process or an apparatus. Accordingly, Applicant has amended the claims into proper method format. Applicant submits that such amendments overcome the rejection and are fully supported in the specification.

III. Rejections under 35 U.S.C. § 101

The Examiner has rejected claims 1-3 under 35 U.S.C. § 101 as allegedly not being directed to statutory subject matter. However, in view of the amendments to claims 1-3, Applicant submits that the rejection is overcome.

IV. Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-3 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,875,550 to Miyakawa ("Miyakawa").

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites that at toner having a largest work function is transferred first onto an intermediate transfer medium.

The Examiner acknowledges that Miyakawa does not disclose the above feature, but contends that it would have been obvious to one of ordinary skill in the art to modify Miyakawa due to the direct teaching of Miyakawa and the known effect of toners having specified work functions (pg. 4 of Office Action).

Applicant respectfully traverses the Examiner's assertion. For example, Miyakawa is merely concerned with forming a non-magnetic single-component toner having external additive particles and mother particles with a specific work function relationship (i.e. the external additives having a work function larger than the work function of the mother particles) (col. 5, lines 14-32; col. 14, lines 25-36). There is no teaching or suggestion of first transferring a toner having a largest work function onto an intermediate transfer medium before transferring other toners, as recited in the method of claim 1. For example, Miyakawa discloses that the toner 8 will be transferred to a recording medium 9, and then states that four colors (Y, M, C, K) can be combined to form a full color image forming apparatus (col. 21, line 17 to col. 25, line 60).

However, there is no teaching or suggestion of which toner of the four color toners should or would be transferred first based on work function. Further, Applicant submits that there is no other teaching in the reference that would suggest such a modification. Applicant submits that the Examiner's alleged modification of Miyakawa is without merit or proper support.

Since the Examiner's argument for obviousness is based on the knowledge of "one of ordinary skill in the art," Applicant respectfully requests the Examiner to cite to a reference or teaching that, when combined with Miyakawa, would disclose the claimed invention.

B. Claims 2 and 3

Since claims 2 and 3 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

V. Double Patenting Rejection

The Examiner has rejected claims 1-3 under the judicially created doctrine of double patenting in view of claims 9-24 of copending Application No. 10/771,618.

Without conceding to the Examiner's statements regarding Application No. 10/771,618, Applicant submits herewith a terminal disclaimer, thereby overcoming the rejection.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/751,306

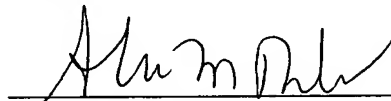
Attorney Docket No.: Q79234

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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